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DICKINSON WRIGHT RLLP
Attn: IP Docketing
P.O. BOX 569
Cupertino, CA 95015
UNITED STATES OF AMERICA

EXAMINER

SHIUE, DONG-CHANG

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex Parte LI LI and ARUN G. MATHIAS

Appeal 2018-005896
Application 14/499,002
Technology Center 2600

Before JUSTIN BUSCH, JASON J. CHUNG, and BETH Z. SHAW,
Administrative Patent Judges.

SHAW, *Administrative Patent Judge.*

DECISION ON APPEAL¹

Appellants² seek our review under 35 U.S.C. § 134(a) of the Examiner’s final rejection of claims 1–20, which are all the pending claims. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

¹ Throughout this Decision we have considered the Appeal Brief filed October 12, 2017 (“App. Br.”), the Examiner’s Answer mailed February 9, 2018 (“Ans.”), and the Final Office Action mailed January 13, 2017 (“Final Act.”).

² Appellants identify Apple Inc. as the real party in interest. App. Br. 4.

INVENTION

Appellants' invention relates to mitigating paging collisions at a mobile device by using device-specific information including International Mobile Subscriber Identity (IMSI) information. Spec. ¶ 5.

Claim 1 is illustrative of the claims at issue and is reproduced below:

1. A method comprising:
at a provisioning server:
receiving, from a mobile device, a first provisioning request comprising at least a portion of a first international mobile subscriber identity (IMSI),
wherein:
 - i) the first IMSI is associated with a first electronic subscriber identity module (eSIM), ii) the first eSIM is present on an embedded universal integrated circuit card (eUICC), iii) the eUICC is included in the mobile device, iv) the request is for a second eSIM, and v) the second eSIM is associated with a second IMSI different than the first IMSI;identifying, based on the at least a portion of the first IMSI, a particular eSIM as the second eSIM to provide to the mobile device; and
providing, to the mobile device, the particular eSIM.

REJECTIONS

The Examiner rejected claim 11 under 35 U.S.C. § 112(b) as being indefinite. Final Act. 2.

The Examiner rejected claims 1, 4-7, 9, 11, 12, 14, 16, and 19 under 35 U.S.C. § 103 as being unpatentable over US 2013/0157673 A1 published June 20, 2013 (Brusilovsky) in view of US 2014/0038666 A1 published February 6, 2014 (Chin). Final Act. 3.

The Examiner rejected claims 2, 3, 8, 13, 15, 17, 18, and 20 under

35 U.S.C. § 103 as being unpatentable over Brusilovsky, Chin, and US 2014/0106750 A1 published April 17, 2014 (Roullier). Final Act. 11.

The Examiner rejected claim 10 under 35 U.S.C. § 103 as being unpatentable over Brusilovsky, Chin, and US 2012/0117635 A1 published May 10, 2012 (Schell). Final Act. 14.

In the Answer, the Examiner withdrew the rejection of claims 3 and 18. Ans. 2. Additionally, the Answer does not repeat the rejection of claim 11 under 35 U.S.C. § 112 made in the Final Rejection. We conclude that the rejection of claim 11 has also been withdrawn. *See Ex parte Emm*, 118 USPQ 180, 181 (Bd. App. 1957) (rejection not referred to in the Examiner's Answer is assumed to have been withdrawn).

CONTENTIONS AND ANALYSIS

Appellants argue the Examiner erred in rejecting claim 1 under 35 U.S.C. § 103 as being unpatentable over the combination of Brusilovsky and Chin. In particular, Appellants argue Brusilovsky does not teach the recited “identifying, based on the at least a portion of the first IMSI, a particular eSIM as the second eSIM to provide to the mobile device.” App. Br. 16. We agree with Appellants.

Appellants point out, and we agree, that Brusilovsky discloses security information, but the reference to security information being associated with an eSIM download does not disclose identifying the eSIM based on a first IMSI. App. Br. 16.

The Examiner finds:

The claim language "based on" in the recited limitation "identifying, based on at least a portion of the first IMSI" is very broad in nature, i.e., anything that is related to first the IMSI can be based on for the subsequent action for the particular eSIM.

Brusilovsky discloses a bootstrapping scheme to download a second (or particular) set of eSIM based on the security of the first eSIM. It is disclosed by Brusilovsky, in at least [0036], lines 4–11, that upon power-up, this device establishes a bootstrap bearer with operator A, uses that bearer to access a subscription manager (SM), uses boot strap credentials (e.g., pre-shared secret, certificate, etc.) to establish bootstrapping session security with the SM, and uses that security information to download a set of eSIM/eUICC credentials and/or a subscription profile for operator B, and [0035], last 2 lines: the identification information can also include an IMSI or parts thereof, wherein examiner construes that that security information is related to the first IMSI and the second eSIM is a particular eSIM for a particular operator B. "that security information" and certificate are related to the first eSIM and therefore identifying a second eSIM is based on the first eSIM.

Ans. 3.

Although the Examiner ties the security information to the first eSIM, there is no disclosure in Brusilovsky that the *security* information of Brusilovsky is based on the IMSI. App. Br. 17. Rather, Brusilovsky appears to distinguish security information from identification information, where identification information can include an IMSI. Brusilovsky ¶ 35. Therefore, on this record, the Examiner has not shown sufficiently how the combination of references teaches “identifying, based on the at least a portion of the first IMSI, a particular eSIM as the second eSIM to provide to the mobile device,” as recited in claim 1.

Thus, we are persuaded of error in the Examiner’s rejection of claim 1 under 35 U.S.C. § 103, and we do not sustain the § 103 rejection of claim 1. For the same reasons, we do not sustain the § 103 rejection of independent claims 9 and 16, as well as the pending dependent claims. Nor do we sustain

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the rejection of the remaining claims because the Examiner does not find the other cited references cure the deficiencies of Brusilovsky discussed above.

DECISION

We reverse the decision of the Examiner to reject claims 1–20 under 35 U.S.C. § 103.

REVERSED